



CERTIFICATE UNDER 37 CFR 1.8(a)
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By: STAAS & HALSEY
Date: JAN 31, 2005

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JFW

Docket No.: 1341.1059

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Mayumi NOGUCHI et al.

Serial No. 09/639,761

Group Art Unit: 2154

Confirmation No. 4065

Filed: August 15, 2000

Examiner: LIN, WEN TAI

For: APPARATUSES FOR GENERATION AND COLLECTION OF INFORMATION, AND
COMPUTER-READABLE RECORDING MEDIUM

PETITION TO WITHDRAW FINALITY OF OFFICE ACTION

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In an Office Action mailed November 29, 2004, the Examiner issued a Final first Office Action. This is a Petition to withdraw the finality of that Action.

Facts

An After Final Amendment and RCE were filed September 14, 2004. In response, the Examiner issued a Final Office Action, mailed November 29, 2004.

Not Same Invention

The reason give for the finality was that "all claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application". However, the claims were not directed to the same invention. For example, the following text was added to claim 4:

[the information collection unit] responds to notices from information generation apparatuses with priorities higher than a preset priority by collecting stored generated information from such information generation apparatuses, and responds to notices corresponding to information generation apparatuses with priorities lower than the preset priority by disregarding such notices by not

collecting stored generated information from respective information
generation apparatuses

This feature was not found in the previously claimed invention. Other substantive language was added to the claims. See also claims 1 and 14.

Although MPEP Chapter 7 does not provide a standard for determining a "same invention", in the context of § 101 double patenting, "'same invention' means identical subject matter" (emphasis added). Also, the Merriam Webster Online Dictionary defines "same" as (emphasis added):

1 a : resembling in every relevant respect b : conforming in every respect -- used with as

2 a : being one without addition, change, or discontinuance : IDENTICAL b : being the one under discussion or already referred to

3 : corresponding so closely as to be indistinguishable

It is respectfully submitted that the amended claims are not identical to the prior claims, they do not resemble or conform to them in every relevant respect, nor are they so similar to the prior claims as to be indistinguishable from them. This conclusion is affirmed by the fact that the Examiner provided significant new remarks and citations to address the amended claims. See items 2, 3, and 4 of the Office Action.

This error alone is sufficient to withdraw the Finality of the Office Action mailed November 29, 2004. Withdrawal of the finality of the Office Action is respectfully requested.

Previous Ground of Rejection Not Sufficient to Reject Amended Claims

The finality is also traversed because the prior grounds of rejection were not sufficient to reject the amended claims.

In item 2 of the new Final Office Action, the Examiner states that "similar issues had been raised in Applicant's response to the previous non-final office action and had been properly responded by the examiner in the previous final office action" (page 8, top). The issue previously raised by the Applicant was that Krishnamurthy always collects a collection request; no collections are disregarded. That is to say, Applicant previously argued that Krishnamurthy acts on all collection requests and does not discard requests based on their priority.

In the previous Office Action (April 15, 2004), the Examiner responded by reasoning that "although Krishnamurthy's method does preserve all requests in a priority queue, it does not

mean that all information would eventually be collected. This is because lower priority information may end up being discarded because of shortage in local storage space". (April 15, 2004 Office Action, item 13, emphasis added). Applicant amended claim 4 to recite (1) responding to notices from information generation apparatuses *with priorities higher than a preset priority* by collecting stored generated information from such information generation apparatuses, and (2) responding to notices corresponding to information generation apparatuses *with priorities lower than the preset priority* by disregarding such notices by not collecting stored generated information from respective information generation apparatuses. In other words, some notices are disregarded based on priority.

The Examiner then issued the new Final Office Action in which the Examiner's reasoning shifted and a new ground of rejection was added. Specifically, the Examiner's new reasoning is that "by setting the priority threshold to the lowest level, Applicant's collection system would produce equivalent result as that of Krishnamurthy, because potentially all the generated data would be collected" (November 29, 2004 Office Action, item 2). *This reason for rejection was not previously presented*. In fact, this reasoning reflects a shift in the Examiner's use of Krishnamurthy to which Applicant has not been given an opportunity to respond.

Regardless of whether the Examiner is correct, this is not the same argument previously made by the Examiner. Respectfully, the record contradicts the Examiner's statement that the claims "could have been finally rejected on the grounds and art of record". Withdrawal of the Finality is respectfully requested.

Incomplete Rejection

Finally, the Finality of the Action is traversed because the rejection is incomplete. The rejection fails to address all features of the claims. The Examiner has not, as required, addressed the actual language and limitations of the claims. Amended claim 4 recites *responding to notices corresponding to information generation apparatuses with priorities lower than the preset priority by disregarding such notices by not collecting stored generated information from respective information generation apparatuses*.

Instead of explaining how Krishnamurthy meets this limitation, the Examiner reasoned that "by setting the priority threshold to the lowest level, Applicant's collection system would produce equivalent result as that of Krishnamurthy, because potentially all the generated data would be collected" (November 29, 2004 Office Action, item 2). In other words, the Examiner is

reasoning that the claims have a case where the threshold is such that all notices are collected. However, the limitation of claim 4 in the paragraph above does not allow such a low threshold. Claims 1 and 4 explicitly recited notice(s) with a priority *below* the threshold. The Examiner's reasoning that the claims have a case where all notices are collected clearly contradicts the explicit limitation that some notices are not collected.

Withdrawal of the Finality is respectfully requested because the Applicant has not been given an opportunity to respond to new grounds of rejection. As stated in MPEP 706.05:

The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application ... The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

Applicant has substantively amended the claims and has been prematurely been cut off in developing issues for appeal. Withdrawal of the Finality is respectfully requested.

Summary

Based on the comments above, withdrawal of the Finality of the November 29, 2004 Office Action is respectfully requested.

If there are any additional fees associated with filing of this Petition, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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